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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,807

10/01/2003

Stephen Alan Smith

3177 P 387

3085

22908 7590 01/24/2007  
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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

01/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Interview Summary</b>	<b>Application No.</b> 10/676,807	<b>Applicant(s)</b> SMITH ET AL.	
	<b>Examiner</b> Stephen J. Castellano	<b>Art Unit</b> 3781	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Stephen J. Castellano. (3) Brad Rademaker (appl. rep.).  
 (2) Mr. Gregory Schlenz (appl. rep.). (4) \_\_\_\_\_

Date of Interview: 16 January 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference  
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
 If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: Of record.

Identification of prior art discussed: Of record.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
**Stephen J. Castellano**  
**Primary Examiner**

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
 Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See summary of applicant's positions (attached). The Edwards-Hawley rejection doesn't provide a raised ledge that sits within the arched portion. This rejection will be withdrawn when the case is taken up for its next action. The case is not in allowable condition due to double patenting rejections. Applicant has traversed the obvious double patenting (ODP) rejections involving design patents on two grounds: (1) double patenting is rare in the context of utility versus design patents as stated in MPEP section 804, II, B, 3 in the first sentence of the second paragraph (August 2005 revision) and in the decision in *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed.Cir. 1983) and (2) that the double patenting rejection should have used two-way obviousness (see the third paragraph, second to last sentence). Also see, MPEP 1504.06, II, sentence bridging col. 1 and 2 of page 1500-52 (August 2005 revision). It has been this examiner's experience that ODP rejections between utility and design patents is not rare in this art and have been upheld by the Board. Therefore, the ODP rejections will be maintained. The secondary considerations have not been presented in affidavit form and will not be considered until submitted by affidavit..

**Summary of Applicant's Positions For Examiner Interview**

Examiner Castellano

January 16, 2007

**Application No. 10/676,807****1. Rejection of Claim 1**

Element: *"the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested upon the container."* (Claim 1).

Neither Hawley nor Edwards discloses having a stacking shoulder with arched portions where the base sits upon the stacking shoulder and the raised ledges sit within the arched portions. The Examiner's proposed combination and modification of the structures of Edwards and Hawley would still not be capable of achieving the structure recited in claim 1, because additional structure is needed to allow the raised ledges to pass the base and reach the arched portions (such as Applicants' beveled portions). As seen in FIG. 3 of Hawley, the base of the container sits on the top of the arches proximate the base of the container, because the container contains no structure to allow the tops of the arches to pass the base as the containers are nested. Edwards contains the same problem. Even if the arched structure of Edwards were moved downwardly so that the base rests upon the interior surface created by the "annular shoulder," the "raised ledges" would contact the bottom of the base (as in Hawley), and would not sit within the arches. Modifying the structures of Hawley and Edwards to address this problem would require the addition of structure not shown in the cited art.

**2. Other Claims**

If the Examiner agrees with Applicants' positions, Applicants are willing to insert the "arched portions" / "raised ledges" elements of claim 1 discussed above and/or the

"beveled edges" element discussed with respect to the latter case below, into the remaining claims.

**Application No. 11/101,932**

**1. Objections to the Drawings**

Applicants do not understand the Examiner's objections to the drawings. The beveled portions 27 and beveled edges 30 are both disclosed and described consistently as "beveled" throughout the application. The beveled portion 27 is beveled and has a beveled edge 30 where the sidewall meets the base. Both of these features are clearly indicated in the drawings. If the Examiner's subjective opinion is that these structures are not beveled, the Examiner is respectfully reminded that an applicant is permitted to be his own lexicographer. The term "beveled" can have many different definitions or interpretations, and Applicants are free to use whichever definition or interpretation they wish. Thus, it is not proper for the Examiner to assert that a particular structure is not beveled when that structure has been consistently described by Applicants throughout the application as "beveled."

**2. Rejections Over Prior Art References**

Elements: *"a substantially circular base defined by an outermost edge of a lowermost surface of the container ... the lower portion further comprising a beveled portion extending from at least one of the arched portions of the annular shoulder to the base, said beveled portion forming a beveled edge on the base."* (e.g., Claim 1).

Applicants submit that none of the cited references disclose a base having beveled edges as recited in the above element. Mair does not disclose a base having beveled edges. The base recited in the above element is defined by the outermost edge of the lowermost surface of the container. The outermost edge of the lowermost surface of the container of Mair is completely round, and thus, the "base" of the cup of Mair has no beveled edges. The angled, upwardly-extending sidewall portion proximate the base of Mair is not part of the lowermost surface. Wanderer '240 does not show a bottom view, but from observation of FIG. 1 of Wanderer '240, it appears that the outermost edge of the lowermost surface is completely round and, thus, does not contain beveled edges.

Wanderer '313 and Edwards '271 also appear to have bases where the outermost edge of the lowermost surface is completely round, rather than beveled. Thus, none of the cited references disclose, teach, or suggest this feature of claim 1.

If the Examiner does not agree with Applicants' position, Applicants propose amending the claims to include the following element:

the sidewall comprises ... a beveled sidewall portion extending from the arched portion of the annular shoulder to the base, said beveled sidewall portion forming a beveled edge portion on the outermost edge of the lowermost surface of the container, said beveled edge portion positioned inwardly from an outermost circumference of said outermost edge

This additional element further distinguishes the structures recited in the claims from the structures shown in the cited prior art references. Modification of the cited prior art references to achieve this recited structure would require the addition of structures not disclosed, taught, or suggested in any of the prior art.

#### **Double Patenting Rejections – Applicable to Both Cases**

The Examiner's double patenting rejections over Applicant's own design patents are not proper. "[I]n design-utility situations, a two-way obviousness determination is necessary for the rejection to be proper. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)." M.P.E.P. § 1504.06 (emphasis added). See also M.P.E.P. § 804 ("double patenting is rare in the context of utility versus design patents"). The Examiner has not made the required two-way obviousness determination. Rather, the Examiner has only asserted that the utility claims are obvious in view of the design claims.

Additionally, Applicants submit that the required two-way obviousness determination cannot be made. Even assuming that Applicants' utility claims are obvious in view of the design claims, the designs claimed in Applicants' design patents are not obvious in view of Applicants' utility claims, because Applicants' utility claims do not specifically recite the shapes of the features in each claim. For example, where a utility claim recites "a longitudinal recess," the ornamental design of the recess in Applicants' design patents is not rendered obvious, because a nearly infinite number of different longitudinal recesses could be designed. In evaluating double patenting rejections

between utility claims and design claims, "[t]he examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the drawings."

M.P.E.P. § 1504.06 (emphasis added). Applicants submit that this cannot be done because the utility claims lack specific detail regarding the shape, contour, etc. of the recited structures.

#### **Secondary Considerations of Nonobviousness – Applicable to Both Cases**

Applicants are prepared to submit evidence of copying as a secondary consideration of nonobviousness. As shown in the attached photographs a cup product ("Cup A") distributed by another cup company after the filing of the present application, and after Applicants' sale of products pursuant to the present application contains the features recited in Applicants' claims. These features have been traced with a black marker in the attached photographs to enhance their visibility. In particular, Cup A includes longitudinal recesses, an annular shoulder having arched portions, and beveled portions forming beveled edges on the base to assist with stacking. (See attached FIGS. 1 and 2). The arched portions form raised ledges on the interior of the cup which sit within the arched portions when the cup is stacked. (See attached FIG. 3). Essentially, Cup A is a copy of the cups disclosed and claimed in the present application, in structure, function, and spirit. The fact that Cup A came on the market so quickly after the publication and sale of Applicants' invention, without any similar cup existing previously, is strong evidence of nonobviousness that must be considered by the Examiner. See M.P.E.P. §2141 ("Objective evidence or secondary considerations such as ... copying by others ... are relevant to the issue of obviousness and must be considered in every case in which they are present.").

(1167606.1)



FIG 1

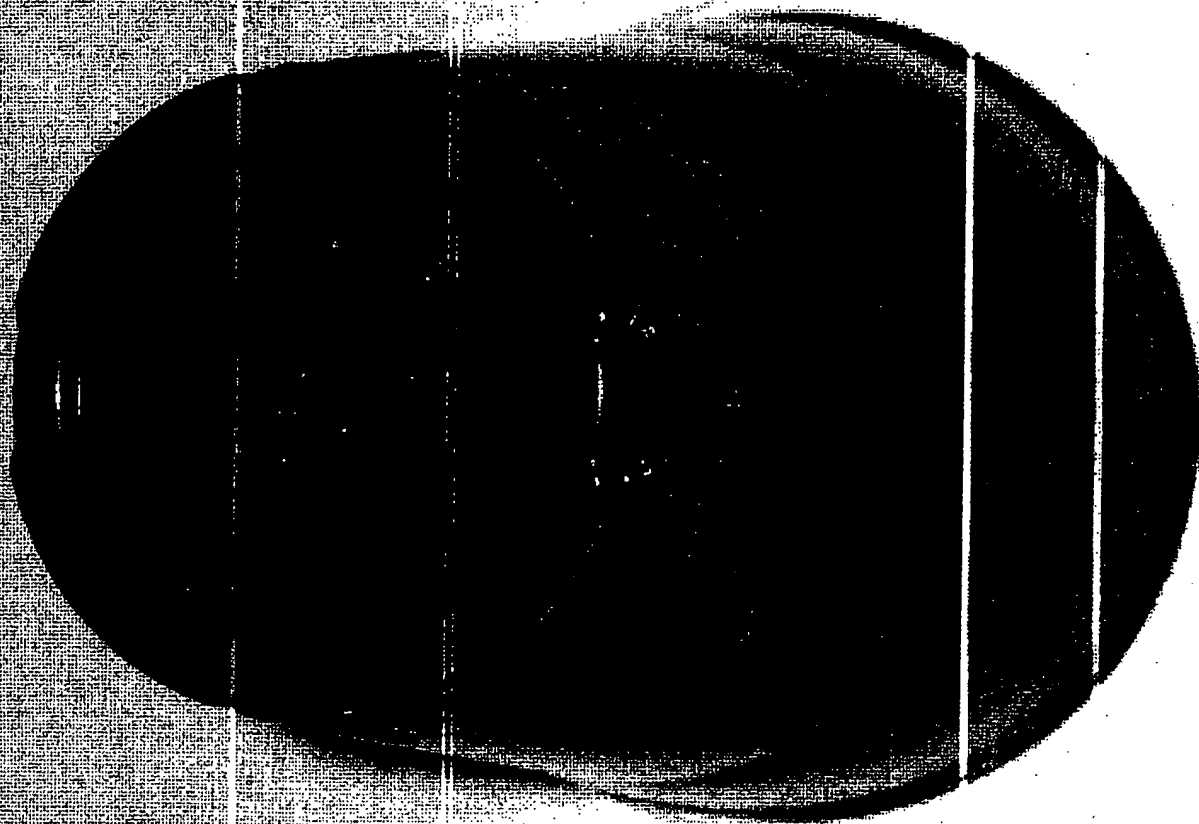
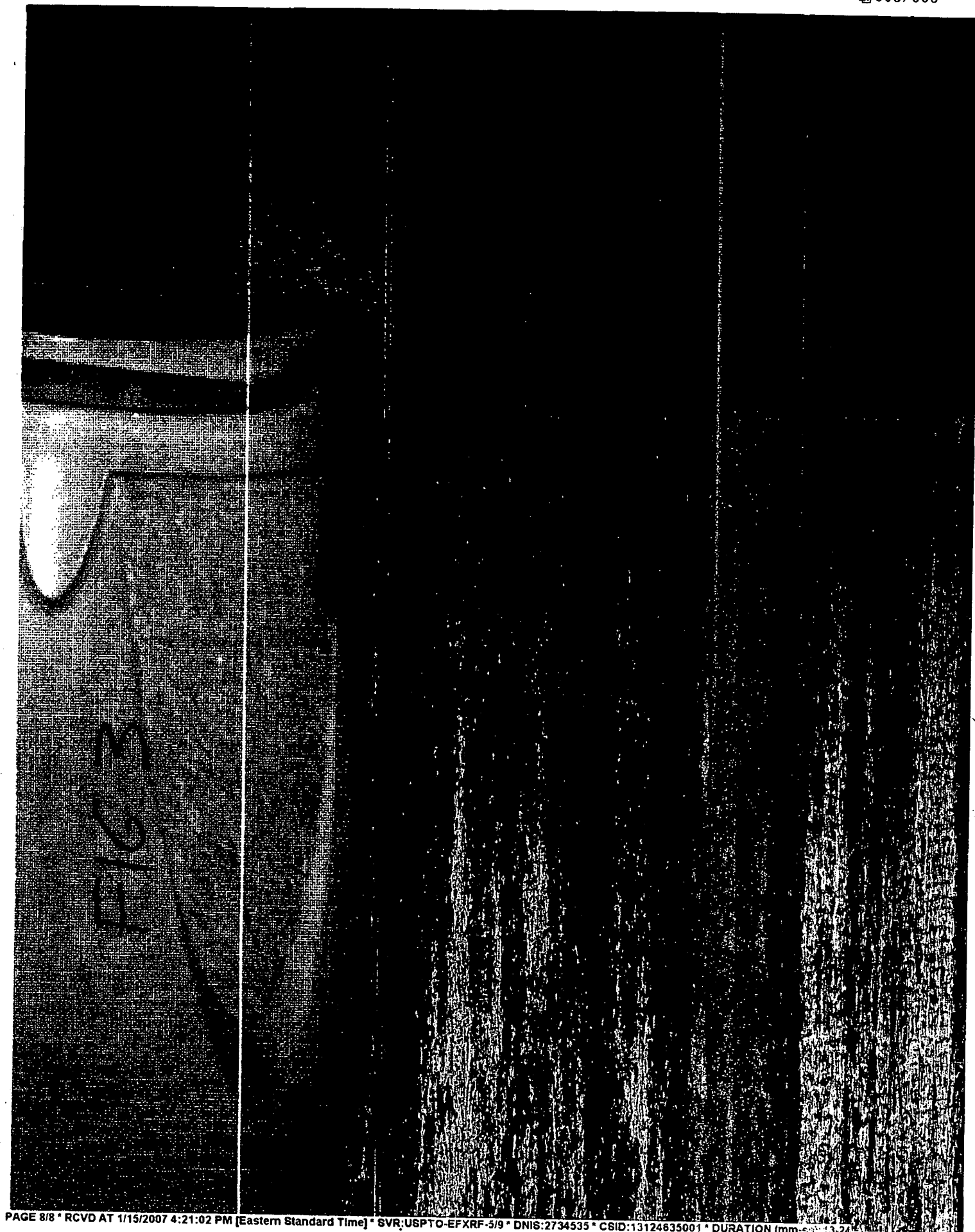


FIG. 2





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**FACSIMILE TRANSMITTAL SHEET**

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<b>TO:</b> Examiner Castellano	<b>FROM:</b> Gregory G. Schlenz Reg. No. 55,597
<b>COMPANY:</b> USPTO	<b>DATE:</b> January 15, 2007
<b>FAX NO.:</b> 1-571-273-4535	<b>TOTAL NO. OF PAGES:</b> (including cover sheet) 8

**RE:** Serial Nos. 10/676,807 and 11/101,932  
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<b>NAME:</b> Susan M. Franklin	<b>PHONE:</b> (312) 463-5547
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**COMMENTS:**

Please see the attached.

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